

REMARKS

Claims 1-18 and 21-24 were pending in the present application. Claims 10, 11, 15, 17, 18, and 23 are amended and claim 16 is cancelled without prejudice. The amendments to claims 10, 11, 15, 17, 18, and 23 involve correcting informalities and do not raise any issue of new matter. Therefore, entry of the present Amendment is respectfully requested. Upon entry of the present Amendment, claims 1-15, 17, 18 and 21-24 will be under examination.

CLAIM REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 1-18, and 21-24 stand rejected under 35 U.S.C. §112, Second Paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants' response to the eleven specific claim rejections are as follows:

- #1. Applicants have amended claim 23 to delete any references to compounds (II) and (III). Therefore, the amendment to claim 23 obviates this rejection. Accordingly, reconsideration and withdrawal of rejection are respectfully requested.
- #2. Applicants respectfully disagree with the objection of the phrase "a silyl, stannyl or phosphorous containing group" in the definition of R^3 as it is clear to one of ordinary skill in the art to know the metes and bounds of the claims by using this term.

Applicants respectfully point out that M.P.E.P. §2173.02 requires that "Definiteness of claim language must be analyzed not in a vacuum, but in light of: (A) the content of the particular application disclosure; (B) the teachings of the prior art; and (C) the claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made."

In the present application, one of ordinary skill in the art would understand the objected phrase as clear and precise in light of the specification which states, at page 3, lines 12-20, that R^3 is an ester-forming carboxyl-protecting groups (emphasis added). Such ester-forming carboxyl-protecting groups can be "a silyl, stannyl or phosphorus-containing group," which may contain Si, Sn or P at any position as long they form esters with the carboxyl group and protect such carboxyl group. It is respectfully pointed out that "the breadth of a claim is not to be equated with indefiniteness." M.P.E.P. §2173.04. Therefore the use of the objected phrase does not render the claims indefinite.

Accordingly, reconsideration and withdrawal of rejection are respectfully requested.

#3. Applicants have amended claim 10 to clarify that X is S, SO, SO₂, O, or CH₂ and Y is halogen. Applicants contend that the amendment to claim 10 obviates this rejection.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

#4. Applicants have amended claim 15 to be dependent upon claim 11. Such an amendment would obviate this ground of rejection. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

#5. Applicants have amended claim 11 to delete the reference to claim 10 and insert formula IV. Applicants submit that such an amendment obviates this ground of rejection. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

#6. Applicants respectfully point out that the Office Action erred in stating "Claim 1 definition for CO₂R³ does not include salt." In fact, Claim 1 clearly defines that "CO₂R³ is CO₂H, a carboxylate salt ..." Therefore, reconsideration and withdrawal of this ground of rejection are respectfully requested.

#7. Claim 16 is hereby canceled without prejudice.

#8. Claim 17 is hereby amended to depend upon claim 11.

#9. Applicants did not find any "rightmost X" in claim 10. However, claim 10 has been amended to clarify that X is S, SO, SO₂, O, or CH₂ and Y is halogen.

#10. Applicants have amended claim 18 to clarify that "the compound (IV) is alkylated with a compound of formula (V) to form a compound of formula (III)."

#11. Applicants have amended claim 18 to replace the phrase "cephem" with actual chemical structures. Applicants believe that such amendments would obviate this ground of rejection. Therefore, reconsideration and withdrawal of this rejection are respectfully requested.

CONCLUSION

The Examiner is encouraged to contact the undersigned at (860) 686-1652 if he has any questions regarding the present Amendment.

It is believed that no fee, other than the three-month extension of time fee, is deemed necessary in connection with the filing of the present Amendment. However, if any other fees are required, the Examiner is authorized to charge any such fees to our Deposit Account No. 16-1445.

Respectfully submitted,

Date: Feb. 18, 2004

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